

REMARKS

Claims 1-3, 5, and 8-14 are now pending in this application for which applicant seeks reconsideration.

Amendment

Claims 1 and 12 have been amended. Claims 4, 6, and 7 have been cancelled. New claims 13 and 14 have been added.

Subject Matter Rejection

Claim 12 stands rejected under 35 U.S.C. §101 because the claimed invention is directed toward non-statutory subject matter. The claim has been amended to recite “a computer-readable storage medium storing a computer program,” which is statutory subject matter. Accordingly, applicant respectfully requests that the rejection be withdrawn.

Art Rejection

Claims 1, 5-6, and 9-12 stand rejected under 35 U.S.C. §102(b) as being anticipated by Ramsay et al. (U.S.P. 5,502,576.) Regarding claims 1, 11, and 12, applicant respectfully traverses the rejection. Ramsay et al. fails to disclose “a searching device that searches the electronic document data within said document management server for original electronic document data corresponding to electronic document data within the read image information,” as claimed. Ramsay et al. merely discloses a computer user manually searching for an archived document on a mainframe. It does not disclose reading in image information and then performing a search for an original electronic document corresponding to that information, as this part of the claim recites. Further, Ramsey et al. fails to disclose “a notifying device that notifies a result of search by said searching device as an electronic mail to an electronic mail address,” as presently claimed. While Ramsey et al. does disclose various peripheral devices like a transmission device such as a modem or facsimile (col. 25, lines 38-43), such devices in themselves do not and cannot disclose the above limitation of the claim. Even further, Ramsey et al. fails to disclose that “the file of the searched original electronic document data is attached to the electronic mail to be transmitted when said setting device sets that the searched original electronic document data is to be attached,” as claimed. For all these reasons, applicant respectfully requests that the above rejection be withdrawn.

Claim 3 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Ramsay et al. in view of Seder et al. (U.S. Pat. App. Pub. 2002/0164063 A1.) Applicant notes that Seder et. al. cannot overcome the deficiencies of Ramsay et al. as set forth above.

Claim 4 stands rejected under 35 U.S.C. §103(a) as being unpatentable in view of Ramsay et al. The limitations of claim 4 are now a part of claim 1. The examiner asserts that since the reference discloses a transmission interface which is connected to the internet and therefore could send email by way of that interface, a person of ordinary skill in the art at the time the invention was made could adapt the method of electronic mail for alerting a user of the search results. Applicant notes, however, that the prior art provides no motivation for such an alteration of the delivery of the search results. Motivation for making such a change must be shown from the prior art or based on some reasoning in order to establish a *prima facie* case of obviousness pursuant to MPEP §2142. Applicant therefore submits that the examiner must provide such evidence an analysis in order to make such an argument against the present construction of the claims in any future office action.

Claims 2 and 7-8 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the combined teaching of Ramsay et al. and Cullen et al. (U.S. Patent No. 5,893,908 A.) Applicant notes that Cullen et al. fails to disclose transmitting a result of a search by the searching device by electronic mail, and hence it cannot overcome the deficiencies of Ramsay et al. as set forth above.

Conclusion

Applicant submits that claims 1-3, 5, and 8-14 patentably distinguish over the applied references and are in condition for allowance. Should the examiner have any issues concerning this reply or any other outstanding issues remaining in this application, applicant urges the examiner to contact the undersigned to expedite prosecution.

Respectfully submitted,

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DATE

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